

### **C. REMARKS**

Applicants respectfully request reconsideration of the outstanding rejections and reexamination of the present application in light of the following amendments and remarks.

#### ***Status of the Claims***

Claims 1, 3-5, 7-16, 18-20, 22-30, and 32 are pending in the application. Claims 1, 16, and 32 are amended and claims 2, 6, 17, 21 and 31 are canceled.

In this Amendment, Applicants have amended claims 1, 16, and 32 and canceled claims 2, 6, 17, 21 and 31 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1-32 prior to this Amendment is not patentable over the art cited by the Examiner. Claims 1, 16, and 32 were amended and claims 2, 6, 17, 21 and 31 were cancelled in this Amendment solely to facilitate expeditious prosecution of the allowable subject matter noted by the Examiner. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1-32, as presented prior to this Amendment and additional claims in one or more continuing applications.

#### ***Alleged Rejection under 35 USC §112, first paragraph***

The Office Action rejects claims 1- 32 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Office Action states "The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this regard one of ordinary skill in the art would not under how to -- determining a call count based on time increment and modifying the call count, (for instance, as recited in claim 1) -- without having more than one calls, which is not provided in the specification in a manner as being claimed."  
[Office Action, p. 2]

Applicants respectfully traverse the rejection under 35 USC §112, first paragraph, as to claims 1 and 16 and respectfully submit that the Office Action fails to meet the burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in Applicant's disclosure a description of the invention defined by the claims. (See MPEP, 2163, IIIA). The Examiner has identified the claim limitations at issue as "determining a call count based on time increment and modifying the call count". [Office Action, p. 2] The Office has improperly interpreted and reworded claim limitations of claim 1, which actually read counting time increments in response to the call, determining a call count based on time increments, and modifying the call count based on calling plan parameters. In addition, the Office has erred in concluding, without consulting the specification and without providing any indication why one of ordinary skill in the art would conclude that when giving the term its broadest meaning consistent with the specification, that a call count as taught in claim 1 must be a count of multiple calls. The actual claim limitations and specification clearly teach a call count **determined based on time increments counted during a call** and clearly teach modifying the call count based on calling plan parameters. There is nothing in the claim limitations on their face that requires more than one call. In view of the improper identification and interpretation of the claim limitations and a lack of basis for the conclusion that there must be more than one call, the Office has failed to establish a prima facie case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.

Furthermore, Applicants direct the Examiner's attention to Paragraph 0019 of the specification, which clearly describes counting time increments during a single call, determining a call count for that call based on the time increments, and modifying the call count based on calling plan parameters. Paragraph 0019 teaches "a timer may be activated when a call is initiated (block 31). The call may be any open communication between the unit 10 and a second party. The call initiation may comprise placing a call from the unit 10, receiving a call, or starting a transmission of information between the

unit 10 and second party. **After the call is initiated, the timer may be activated to count time increments of the call.** The time increments may comprises second, minutes, or any other suitable division of time. The timer may comprise the clock chip 14 and communicate the data and timer data to the controller 20. The timer may continue to count time increments until the call is terminated (block 32). **A call count may be determined (block 33) based on the time increments of the call.** In one embodiment, the call count may comprise the total call time duration in minutes and seconds." Paragraph 0020 of the specification clearly reads: "**The call count may then be modified (block 34) based on calling plan parameters.**" There is no portion of the claims as originally presented or the specification, which requires multiple calls to perform the actual limitations of the claims.

Without conceding that the Office has failed to establish a required prima facie case of obviousness as the rejection under 35 U.S.C. §112, first paragraph, Applicants have amended claims 1 and 16 to clarify and expedite prosecution, based on the specification, including paragraph 0019, to teach: counting time increments in response to initiation of the call and in response to termination of the call, determining a call count of a total call time duration based on the time increments; modifying the call count based on calling plan parameter; summing the modified call count with at least one other call count from at least one other call; and determining an accumulated call count from the summing.

Moreover, Applicants respectfully submit that the Office has erred in rejecting claim 32 under 35 USC 112, first paragraph when claim 32, as previously presented clearly teaches counting time increments by a timer in response to the initiation of a call; determining a call count of a total duration of the call based on time increments counted by the timer; modifying the call count based on calling plan parameters for the cellular telephone unit; and storing the modified call count in the memory of the cellular telephone unit. The Office appears to have overlooked the limitations in claim 32, as previously presented, which read directly on paragraph 0019. One of ordinary skill in

the art would clearly understand how to perform the elements of claims 32 for a single call.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection under 35 USC §112, first paragraph as to claims 1, 16, and 32, and claims 3-5, 7-15, 18-20, and 22-30 which depend upon claims 1 and 16.

***Alleged Rejection under 35 USC §101***

The Office Action rejects claims 1-32 under 35 USC §101 as allegedly disclosing an invention that is inoperative and therefore lacks utility. [Office Action, pp. 2-3] In particular, the Office Action states:

The invention defined by the claimed methods, means, and system does not perform the recited features, for instance as recited in claim 1, --- determining a call count based on time increments; and modifying the call count based on calling plan parameters. It may count only time in response to a received call; but, it is not operational to count calls and thus cannot modify a call count, as there is no more than one call supported by the claims. Furthermore, the claimed system and/or method is not capable of "subtracting the modified call count from a time ratio" as recited in claims 3 and 18 and further is not capable of "rounding the call" as recited in claims 4 and 19, since there is no more than one call (since there is only one call) to begin with. In other words, subtraction or modification, within the context of the claims 3, 4, 18 and 19, requires a given quantity of calls, which is absent from these claims, thereby making the claims inoperable. For examination purposes, claims 1-32 are considered as calling for --- counting, summing and modifying a call time as a function of a call. [Office Action, p. 3]

Applicants respectfully submit that the Office has erred in interpreting claim 1 as being required to teach counting a number of calls for the claim to disclose an operative invention. Clearly, claim 1 teaches a call count determined from the time increments counted during a call. Claim 1 clearly teaches multiple time increments counted during a call. The time increment based call count, which includes a quantity of time increments counted during a call, can be modified and subtracted from. Not only does the claim language on its face support a time increment based call count, but the

specification, throughout, and for example in paragraph 0019, specifically states that “the call count may comprise total call time duration in minutes and seconds.” The Examiner states that “for examination purposes, claims 1-32 are considered as calling for – counting, summing, and modifying a call time as a function of a call.” However, there is no indication why a call count, as already taught in the claim, particularly when the claim is properly considered as a whole, teaches anything other than the time increments counted during a call. Applicants respectfully submit that when the actual elements of claim 1 are considered, it is clear that the invention is operative and has utility, as required under 35 USC §101.

Without conceding that the Office has failed to establish lack of utility, to expedite prosecution, Applicants have amended claims 1 and 16 to clarify the operability, based on the specification, including paragraph 0019, to teach: counting time increments in response to **initiation of the call** and **in response to termination of the call**, determining a call count **of a total call time duration** based on **the** time increments; modifying the call count based on calling plan parameter; **summing the modified call count with at least one other call count from at least one other call**; and **determining an accumulated call count from the summing**.

As to claims 3, 4, 18 and 19, Applicants respectfully submit that particularly in view of the amendment to claims 1 and 16, it is clear that that the call count and modified call count of claim 1 are both based on time increments, and therefore are counted as a function of time. Therefore, claims 3 and 19 of subtracting the modified call count from a time ratio and claims 4 and 18 of rounding the modified call count up to the next whole minute, are all based on time based quantities and are clearly operative on their face.

Moreover, Applicants respectfully submit that the Office has erred in rejecting claim 32 under 35 USC 101 when claim 32, as previously presented clearly teaches counting time increments by a timer in response to the initiation of a call; determining a call count of a total duration of the call based on time increments counted by the timer; modifying the call count based on calling plan parameters for the cellular telephone unit;

and storing the modified call count in the memory of the cellular telephone unit. The Office appears to have overlooked the limitations in claim 32, as previously presented, which read directly on paragraph 0019. The elements of claim 32 clearly disclose an invention that is operative without requiring multiple calls.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection under 35 USC §101 as to claims 1, 16, and 32, and claims 3-5, 7-15, 18-20, and 22-30 which depend upon claims 1 and 16.

***Alleged Rejection under 35 USC §112, second paragraph***

The Office Action rejects claims 1-32 under 35 USC 112, second paragraph, as allegedly being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. [Office Action, pp. 3-4] The Office Action states:

The omitted structural cooperative relationships are: calls that are more than one in number (for instance, call number 1, call number 2, etc.), which are to be counted and modified by the claimed controller within the claimed phone unit. As indicated, for instance, in claim 1, the features, -- determining a call count based on time increments; and modifying the call count based on calling plan parameters, requires the presence of more than one call to be counted as a function of time. Claims 3 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case "subtracting the modified call count from a time ratio" since the unit of call and time are different the two quantities can not be subtracted from each other. For examination purposes, claims 1-32 are considered as calling for --- counting, summing and modifying a call time as a function of a call.

Applicants respectfully submit that the Office has erred in interpreting claim 1 as lacking essential structural cooperative relationships of elements and respectfully submit that the Office's conclusions are based on a lack of proper interpretation of claim 1 as a whole. The preamble of claim 1 and one of the elements of claim 1 not considered by the Examiner teaches Method of tracking communications usage time by a controller within a phone unit during a call comprising: and counting time increments in response

the call. Clearly, multiple time increments are counted during a call, in response to the call. There is clear structural cooperative relationships between counting time increments in response to the call, and determining a call count based on time increments and modifying the call count based on calling plan parameters. Nothing in claim 1 reads on the call count being a count on the number of calls. Claim 1 clearly teaches counting time increments during a single call, determining a call count based on the time increments, and modifying the call count based on calling plan parameters. It is not necessary for there to be more than one call, as proposed by the Examiner, for the call count to be counted as a function of time. The time increments are a function of time and the call count is based on the counted time increments for the call. The Examiner states that “for examination purposes, claims 1-32 are considered as calling for – counting, summing, and modifying a call time as a function of a call.” However, there is no indication why a call count, as already taught in the claim, particularly when the actual elements of the claim are considered, teaches anything other than the time increments counted during a call. Applicants respectfully submit that when the actual elements of claims 1 and 16 are considered, it is clear that the invention is operative and has utility, as required under 35 USC §101.

Without conceding that the Office has failed to establish a prima facie case under 35 USC §112, second paragraph, to expedite prosecution, Applicants have amended claims 1 and 16 to clarify the structural cooperative relationships of elements, based on the specification, including paragraph 0019, to teach: counting time increments in response to **initiation of the call** and **in response to termination of the call**, determining a call count **of a total call time duration** based on **the** time increments; modifying the call count based on calling plan parameter; **summing the modified call count with at least one other call count from at least one other call; and determining an accumulated call count from the summing.**

As to claims 3 and 18, Applicants respectfully submit that particularly in view of the amendment to claims 1 and 16, it is clear that that the call count and modified call count of claim 1 are both based on time increments, and therefore are counted as a

function of time. Therefore, claims 3 and 19 of subtracting the modified call count from a time ratio is subtracting a time based call count from a time ratio. The claims particularly point out and distinctly claim the subject matter applicant regards as the invention.

In view of the foregoing, Applicants respectfully request withdrawal of the rejection under 35 USC §112, second paragraph as to claims 1, 16, and 32, and claims 3-5, 7-15, 18-20, and 22-30 which depend upon claims 1 and 16.

***Alleged Rejection under 35 USC 102(e) and 103(a)***

The Office Action rejects claims 1, 2, 3, 4, 16, 17, 18, 19, 31, and 32 under 35 USC §102(e) as being anticipated by Tysor (US Publication 2002/0151293). [Office Action, p. 5] In addition, the Office Action rejects claims 6-8, 21-23, and 32 under 35 USC §103(a) as being obvious under Tyser in view of Toda/NEC CORP (JP 07066909). [Office Action, p. 7] The Office Action rejects claims 5 and 20 under 35 USC §103(a) as being unpatentable over Tysor in view of Kraushaar et al (US Patent 4,200,771). [Office Action, p. 9] The Office Action rejects claims 9-13 and 24-28 under 35 USC §103(a) as being unpatentable over Tysor in view of Spitaletta et al (US Patent 6,112,077). [Office Action, p. 9] The Office Action rejects claims 14-15 and 29-30 under 35 USC §103(a) as being unpatentable over Tysor in view of Brown (US Patent 5,987,107). [Office Action, p. 9]

Applicants have amended claims 1 and 16 to incorporate the elements of claims 2, 6, 17 and 21, and cancelled claims 2, 6, 17, 21, and 31. Applicants traverse the rejection of the claims in view of the amendments, and in particular, Applicants respectfully submit that the Office fails to establish a prima facie case of obviousness as to claims 6 and 21, therefore claims 1 and 16, as amended to incorporate claims 6 and 21, are not obvious and should be allowed. Although Applicants amend the claim in the present application, Applicants do not concede that the Examiner has established a prima facie case of obviousness as to the claims as originally presented.



"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

The Examiner bears the initial burden of supporting any prima facie conclusion of obviousness. See *In re Rinehart*, 531, F.2d 1048, 189, USPQ 143 (CCPA 1976); *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007); MPEP 2142. The key to supporting a rejection under 35 USC 103 is the clear articulation of the reasons why the claimed invention would have been obvious; the analysis supporting a rejection under 35 USC 103 should be made explicit. See *KSR International Co.*, 82 USPQ2d at 1396; MPEP 2142 (Rev. 6, Sept. 2007).

Applicants respectfully submit that when a proper Graham inquiry is made a prima facie case of obviousness is not established and the claims should be allowed.

Claim 1, as amended to incorporate claim 6 (italicized), currently reads:

Claim 1 (Currently Amended): Method of tracking communications usage time by a controller within a phone unit during a call comprising:  
counting time increments in response to initiation of the call;  
in response to termination of the call, determining a call count of a total call time duration based on the time increments; [[and]]  
modifying the call count based on calling plan parameter by  
reducing the call count proportional to a pre-determined discount specified  
in the calling plan parameters for discounting an incoming call;  
summing the modified call count with at least one other call count  
from at least one other call; and  
determining an accumulated call count from the summing.

With respect to claims 6 and 21, the Office Action previously rejected claim 6 on the following grounds:

Tysor discloses a method, wherein modifying the call count comprises based on a calling plan parameters comprises reducing (subtracting) the call count proportional to a pre-determined calling plan parameters (see paragraphs 0011, 0043). But, Tysor does not explicitly teach about a call count based on a pre-determined discount for discounting an incoming call (incoming call time). However, in the same field of endeavor, the NEC abstract teaches about a telephone set comprising a counter for recording the calls performed and an adder for accumulating/storing the calls counted during a discounted tariff time period based on the output of a clock (see abstract). It is to be noted that the accumulated call count can be considered as a modified call count since the accumulated call count is not the same as the initial call count. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Tysor with that of Toda for the advantage of a subscriber to optimize utilization of discount tariff during a specified time period. [Office Action, pp. 7-8]

Applicants respectfully submit that NEC/Toda does not teach actually reducing any counted number proportional to a pre-determined discount. NEC/Toda at most describes separately counting a number of calls during a particular time period, that is labeled as a "discounted tariff time". No portion of NEC/Toda teaches reducing any amount or modifying any counted amount, after the amount is counted. Merely because Toda describes counting calls occurring during a particular time period does not mean that Toda teaches what is claimed of reducing the time increments counted during the duration of a call proportional to a pre-determined discount. Therefore, in considering the scope and content of the prior art, the Office errs in concluding that the scope and content of NEC/Toda reads on reducing the call count proportional to a pre-determined discount specified in the calling plan parameters for discounting an incoming call.

In considering the differences between the prior art and claim 1 as amended to incorporate dependent claim 6, it is clear that the references, separately or in combination, do not teach or disclose the claimed reducing the call count proportional to a pre-determined discount specified in the calling plan parameters for discounting an incoming call.

Therefore, in view of the scope and contents of prior art and the differences between the prior art and claim 1, it is clear that the differences between the prior art

and claim 1 are not such that claim 1 as a whole would have been obvious to one of ordinary skill in the art at the time of the invention. Because claim 1 as a whole would not have been obvious to one of ordinary skill in the art at the time of the invention, Applicants respectfully request withdrawal of the rejection under 35 USC 103(a) and allowance of the claims. *KSR*, 82 USPQ2d at 1396; *Dann v. Johnston*, 425 U.S. 219, 230 (1976).

Claims 16 and 32 are rejected on the same grounds as claim 1, and amended in similar manner as claim 1, and are allowable for at least the same reasons that claim 1 is allowable.

As to claims 3-5, 7-15, 18-20, and 22-30, Applicants respectfully submit that because these claims are dependent upon claims 1 and 16, which are allowable, claims 3-5, 7-15, 18-20 and 22-30 are not obvious and should be allowed. *In re Fine*, 837 F.2d 1071, 5 USPQ 1596 (Fed. Cir. 1988).

**Conclusion**

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

No extension of time is believed to be necessary. If, however, an extension of time is required, the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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